

opportunity to discuss the Applicant's view of the Office Action hereby responded to. Although no agreement was reached with respect to the issues raised by the Applicant, it was understood that the Applicant's suggestion that an amendment of the claims to convert one of the dependent claims to a third independent claim, which includes limitations expressed as the definition of the term "secret site" in the second and fourth paragraphs of the Detailed Description of the Invention, would assist the Examiner in a reconsideration of the Examiner's rejections.

Claim rejections - 35 USC § 102

1. In Section 1 of the Office Action the Examiner states that "Claims 1, 8, and 14 are rejected under 35 U.S.C. 102(b) based on a public use or sale of the invention of Baker, U.S. Patent No. (5,961,645)." Said rejection is respectfully traversed, and reconsideration of said rejection is hereby solicited. Specifically, the Examiner alleges that Baker discloses an internet operation in which one or more of the web sites are "secret sites having URLs which are not publicly associated with said internet operation", but does not allege anticipation by Baker. This allegation seems to fail to identify the use of the term "secret site" as a term of art in the present application. The only part of Baker referred to by the Examiner is the "Background of the Invention", presumably in support of the allegation of "public use": there is no reference whatsoever to the invention disclosed in Baker of "filtering for public databases with naming ambiguities". However, there is no mention of the employment of "secret sites" in the "Background of the Invention" of Baker, either by use of the term itself, or by the meaning attached thereto in the second and fourth paragraphs of the "Detailed Description of the Invention" of the present Application. The Applicant respectfully directs the Examiner to the definition of the term "secret" stated in every standard dictionary of the English language.

--SECTION--608.01(g) Detailed Description of Invention

... "An applicant is ordinarily permitted to use his or her own terminology, as long as it can be understood..."

* * *

"The description is a dictionary for the claims and should provide clear support or antecedent basis

for all terms used in the claims. See 37 CFR 1.75, MPEP Section 608.01(i), Section 608.01(o), and Section 1302.01."

--SECTION---608.01(o) Basis for Claim Terminology in Description

"The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; . . . A term used in the claims may be given a special meaning in the description. No term may be given a meaning repugnant to the usual meaning of the term."

--SECTION---2111.01 Plain Meaning

" . . . It is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language. In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970). . . ."

Nevertheless, the Applicant is free to reasonably define a term for use in an application. MPEP 2111.01. As stated in MPEP 2111.01: "Applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well known usage. In re Hill, 161 F.2d 367, 73 USPQ 482 (CCPA 1947)."; and as stated in MPEP 608.01(g): . . . "An applicant is ordinarily permitted to use his or her own terminology, as long as it can be understood. . . ." In the present Application the Applicant has provided, in the second and fourth paragraphs "Detailed Description of the Invention" thereof, a clear definition of "secret sites" which includes the word "secret" in combination with the word "sites", as known in the vocabulary of the internet, which is not repugnant to the "common understanding" of the term "secret" or "sites", and is within the right of the Applicant to be his own lexicographer. As stated in In re Hill, 161 F.2d 367, 73 USPQ 482 (CCPA 1947): "Applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well known usage."

The Applicant has also amended Claim 20 to be a third independent claim which includes limitations expressed as the definition of the term "secret site" in the second and fourth paragraphs of the Detailed Description of the Invention, to wit: 1) maintenance of a secret site URL as a secret from all but those users who have been given the knowledge thereof by the operator; 2) assignment of a secret site URL upon the user's request and in response to the user providing means by which they can be sufficiently identified; and 3) the unavailability of the knowledge of the existence,

identity and URL of each of said secret sites to the public except through a process requiring a sufficient identification of the user. These limitations are the features which define a secret site, and as such are already present in Claim 1. None of these features are mentioned in Baker in any form, and therefore Claims 1 and 14 should be allowed on the same ground.

Claim rejections - 35 USC § 103

2. In Sections 2-5 of said Office Action the Examiner states that claims 2-7, 9-13, and 15-20 "are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker, U.S. Patent No. (5,961,645) in view of" Jablon, Klug, and Waldner (variously according to specific dependent claims). Said rejections are respectfully traversed, and reconsideration of said rejection is hereby solicited. This rejection is based upon the Examiner's allegation that Baker shows all the claimed limitations except for the particular features are supplied by Jablon, Klug, and Waldner for the specific dependent claims to which they are applied in the Examiner's rejections thereof. As shown in Section 1 of this response, it is clear that the "Background of the Invention" of Baker does not include all of the limitations of Claims 1 and 14. Therefore, the "Background of the Invention" of Baker cannot serve as a foundational reference for the Examiner's obviousness rejections, even if Jablon, Klug, and Waldner disclose the missing limitations stated in Claims 2-7, 9-13, and 15-20.

The inapplicability of Baker as a primary reference aside, the Examiner's analysis in this case must begin with the first two of the four factual inquiries enunciated Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966) as a background for determining obviousness: determination of the scope and contents of the prior art; and ascertainment of the differences between the prior art and the claims in issue. It is respectfully suggested that the Examiner has failed to properly ascertain the background for carrying out any test for *prima facie* obviousness as required by the Graham factual inquiries, and therefore any such determination of *prima facie* obviousness lacks the proper predicate therefor in any event.

As correctly stated by the Examiner, "Baker doesn't expressly disclose" any feature related to the "secret sites" of the present invention. The Examiner, however, alleges other features which

are missing in Baker to be disclosed in Jablon, Klug, and Waldner as the secondary references for the obviousness rejection of Claims 2-7, 9-13, and 15-20. With respect to the issue of the motivation to combine, there is no line of reasoning by the Examiner in any form as to how the teachings *actually present* in the references applied would be combined by an artisan of *any* level of skill. The Examiner's standard for determining a *prima facie* case of obviousness, in said Office Action", permits the Examiner to *select a mere aggregate* of references which are not associated by any form of suggestion, but which contain the concepts and terms that are used in the present disclosure, as components for a *prima facie* case, without *any* rationale from those references or scientific principle as to why they should be combined to produce the invention. The Examiner is respectfully reminded that the mere fact that references can be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination. In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). MPEP 2143.01. The Examiner is also respectfully reminded that a statement that modifications of the prior art to meet the claimed invention would have been within the ordinary skill of the art because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. As stated earlier, not only has the Examiner failed to point out any such suggestion, but any such suggestion is also completely absent from the references applied. Moreover, by reason of the nature of Jablon, Klug, and Waldner, there could not possibly be a motive to use "secret sites" as defined in the second and fourth paragraphs of the "Detailed Description of the Invention" of the present Application.

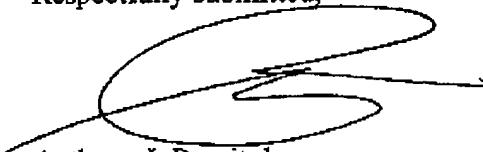
To establish a *prima facie* case of obviousness, three basic criteria must be met; the first is that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). This is the standard that was stated in slightly different terms in *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985): "To support the conclusion that the claimed invention is directed to

obvious subject matter, either *the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning* as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references (emphasis supplied)." Not only are neither of the alternative grounds emphasized in the quotation of *Ex Parte Clapp* validly possible from the references applied to the present disclosure, because of the erroneous analysis of their substance, but neither of the alternative grounds are present in said Office Action *at all*. There is no suggestion whatever in the references applied, express or implied, for the use of the features of Jablon, Klug, and Waldner in Baker, and there is no line of reasoning by the Examiner in any form as to how the teachings *actually present* in the references applied would be combined by an artisan of *any* level of skill.

From the foregoing analysis of said Office Action it is clear that the allegation of *prima facie* obviousness of the present invention is unfounded under the Graham factual inquiries, and otherwise does not comply in any of the assertions made in said Office Action with the requirements of MPEP 2141-2144.

In view of the above, each of the presently pending claims in this application are considered patentable over the references applied. Accordingly, the Examiner is respectfully requested to reconsider his rejections and this application as amended.

Respectfully submitted,



Anthony I. Provitola,
Applicant

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (Fax No. (703) 872-9306) on December 18, 2003.

Typed or printed name of the person signing this certificate:

Anthony I. Provitola

Signature:

A handwritten signature in black ink, appearing to read "Anthony I. Provitola". It is written in a cursive style with a prominent, sweeping initial stroke.

Amendment of the CLAIMS**What I claim as my invention is:**

Claim 1. (currently amended) An internet operation including a system of secret internet web sites comprising:

- (a) a plurality of computers programmed to operate as web servers;
 - (b) one or more of said web servers hosting internet web sites for said internet operation;
 - (c) one or more of said internet web sites being main sites having URLs which are publicly associated with said internet operation accessible through said internet web sites;
 - (d) one or more of said internet web sites being secret sites having URLs which are not publicly associated with said internet operation;
- said secret sites being a part of said internet operation by which said internet operation may be accessed.

Claim 2. (original) The internet operation of Claim 1 wherein the system of secret internet web sites is operated to secure said internet operation against cybervandalism.

Claim 3. (original) The internet operation of Claim 1 wherein the system of secret internet web sites is operated to secure said internet operation against denial-of-service attacks.

Claim 4. (original) The internet operation of Claim 1 wherein one or more of said secret sites are assigned to one or more users of said internet operation.

Claim 5. (original) The internet operation of Claim 1 wherein the URLs of secret sites are maintained as secret by entities authorized by the operator of the internet operation from all but those users who have been given the knowledge thereof by said operator.

Claim 6. (original) The internet operation of Claim 1 wherein the URL of a secret site is acquired by a user through assignment to a user by an entity authorized by the operator.

Claim 7. (original) The internet operation of Claim 1 wherein a secret site is one whose existence, identity and URL are learned by a user only through the process of subscription.

Claim 8. (original) The internet operation of Claim 1 wherein the user is free to contact and use the main site anonymously as permitted and desired.

Claim 9. (original) The internet operation of Claim 1 wherein a user may subscribe for a secret site URL while the main site is under attack.

Claim 10. (original) The internet operation of Claim 1 wherein the telephone subscription system based on telephone contact is automated to provide a secret site URL.

Claim 11. (currently amended) The internet operation of Claim 1 wherein subscription by a user during an attack is through another internet operation[[, one]] which is completely independent of the internet operation [[on the]] which includes said main [[site]] sites.

Claim 12. (original) The internet operation of Claim 1 wherein a reserve of secret sites is maintained that become available to the users of said internet operation in the event of an emergency created by an attack.

Claim 13. (original) The internet operation of Claim 1 wherein the secret site program queries the user for the identification, verifies the information, and proceeds to assign one of the secret site URLs to the user.

Claim 14. (currently amended) A system of secret internet web sites, comprising:

- (a) a plurality of computers programmed to operate as web servers;
- (b) one or more of said web servers hosting internet web sites for an internet operation;
- (c) one or more of said internet web sites being secret sites having universal resource locators (URLs) which are not publicly associated with any internet operation; which are operated to provide access to internet operations of other operators of internet web sites.

Claim 15. (original) The system of secret internet web sites of Claim 14 wherein the system of secret internet web sites is operated to secure other internet operations against cybervandalism.

Claim 16. (original) The system of secret internet web sites of Claim 14 wherein the system of secret internet web sites is operated to secure other internet operations against denial-of-service attacks.

Claim 17. (original) The system of secret internet web sites of Claim 14 wherein the URLs of secret sites are maintained as secret by entities authorized by the operator of said system from all but those users who have been given the knowledge thereof by said operator.

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Claim 18. (original) The system of secret internet web sites of Claim 14 wherein the telephone subscription system based on telephone contact is automated to provide a secret site URL to subscribing users.

Claim 19. (original) The system of secret internet web sites of Claim 14 wherein a reserve of secret sites is maintained that become available to the users of internet operation served by such a system in the event of an emergency created by an attack.

Claim 20. (currently amended) [[The]] An internet operation including a system of secret internet web sites of Claim 14 wherein a secret site program queries a user for the identification information, verifies the information, and proceeds to assign one of the secret site URLs for access of the internet operation sought by the user comprising:

- (a) a plurality of computers programmed to operate as web servers;
- (b) one or more of said web servers hosting internet web sites for said internet operation;
- (c) one or more of said internet web sites being main sites having URLs which are publicly associated with said internet operation accessible through said internet web sites;
- (d) one or more of said internet web sites being secret sites having URLs which are not publicly associated with said internet operation; wherein each of said secret sites have a URL

which:

1. is maintained as a secret from all but those users who have been given the knowledge thereof by the operator; and
2. is assigned to a user upon the user's request and in response to the user providing means by which they can be sufficiently identified for purposes of the level of security against attack desired by the operator;
and wherein the knowledge of the existence, identity and URL of each of said secret sites is not available to the public except through a process requiring such identification of the user;
said secret sites being a part of said internet operation by which said internet operation may be accessed.